

### **REMARKS**

Applicant respectfully submits that all the claims presently on file are in condition for allowance, which action is earnestly solicited.

### **THE CLAIMS**

#### **REJECTION UNDER 325 USC 103**

Claims 1-2, 6-10, 14-18, 22-26 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over BizRate.com at: [http://web.archive.org/web/19981205082910/http://www.bizrate.com/] in view of Peters et al. [USP 5,893,098], that are collectively referred to as "the cited references". Applicant respectfully traverses this rejection and submits that the claims on file are not obvious in view of the cited references and are patentable thereover. In support of this position, Applicant submits the following arguments:

#### **A. Legal Standards for Obviousness**

The following legal authorities set the general legal standards in support of Applicants' position of non obviousness, with emphasis added for added clarity:

- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art**. In re Royka, 490

F.2d 981, 180 USPQ 580 (CCPA 1974). "**All words in a claim must be considered** in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.**). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). "**Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir.

2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

- "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings." See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).
- "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).
- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed**." See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).

- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, **then there is no suggestion or motivation** to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

#### **B. Brief Summary of the Present Invention**

Prior to presenting substantive arguments in favor of the allowability of the claims on file, it might be desirable to summarize the present invention. As indicated by the title and throughout the patent application, **the present invention relates to a system and method for integrating on-line user ratings of businesses with search engines,**" and addresses the problem facing current search engines that "use a variety of criteria to order matches to the user query and to rank the search results with higher quality search matches to **higher business satisfaction ratings**."

It is important to clarify and to reemphasize that the present invention is addressed to businesses. A business is defined as a company or other organization that buys and sells goods, makes products, or provides services.

It is quite obvious that a business should not be confused with, or used interchangeably with, the user of the system.

Assessing quality involves both accurately matching the user query and identifying a useful, current web page. For instance, search engines may order the matches based on what is referred to herein as "static criteria". Exemplary static criteria are the highest popularity, most recently updated, most visited, most queried, or most interconnected. It is common for users to limit the review of their search to only the first few matches of the search list." (Reference is made to page 2, line 17 through page 3, line 4 of the specification.)

The present invention also aims at providing an "adequate mechanism by which searches of business sites can be ordered based upon interactive criteria about the businesses themselves, correlating higher quality search matches to higher business satisfaction ratings. For example, popularity, is a commonly used static criterion which is determined by the number of visits or queries of business sites, and which may depend on advertising, strategic business alliances, or creative naming of a site, and is therefore independent of customers satisfaction with the ranked businesses. Therefore, there is still an unsatisfied need for a system and method that integrate user provided interactive criteria, such as customers and on-line users' satisfaction, with search engine results." Reference is made to page 3, lines 12-20 of the specification. Exemplary on-line sources include questionnaires and other on-line surveys obtained through other web based rating services. The business ratings assess the quality of the businesses in terms of

"interactive" criteria such as customer satisfaction, professionalism, and cost and ease of use of products or services. (Reference is made to page 4, lines 6-9 of the specification.)

The business rating system integrates the ratings with the search results, and ranks and presents the integrated search results to the user based on such ratings. In this manner, the user of a search engine receives feedback from other users and/or customers about businesses of interest. (Reference is made to page 4, lines 12-14 of the specification). In a preferred embodiment, the users complete and submit on-line surveys that are integrated with the search engine results. The information provided by the users is recorded and evaluated for the purpose of ranking the businesses. The ratings are made available to future users of the search engines. In another embodiment, in addition to a numerical rating system, the current on-line users may include descriptive annotations regarding customer satisfaction to be read by future users. In this manner, qualitative as well as quantitative feedback may be provided by the current users and examined by future users. (Reference is made to page 5, lines 5-12 of the specification.)

In use, the on-line ranking system receives users' on-line surveys or feedback, and generates ranking data for storage in the on-line ranking repository. The user profile history enables the user to update or override the rating previously provided by this user but not the ratings provided by other users. (Reference is made to page 10, lines 12-14 of the specification). The cumulative rating computation can be weighted based upon other ratings

a particular user may have provided. Reference is made to page 15, lines 2-3 of the specification).

The query results are referred to the ranking based result sorter, where the query results are cross-referenced with the items stored in the ranking repository. The sorter ranks the query matches accounting for the on-line provided ratings. By providing the ratings for a site across from its occurrence in a search result, a user can select the business that best suits that particular user's needs.

In addition, **the business rating system is a self correcting system** in that after a certain period of use, the users' interactive ratings could significantly affect the ranking of the businesses, and ultimately, lower ranked businesses stand lower chances of being browsed and thus selected. For example, if a user selects a site that had an initially high ranking and was not satisfied with the business, that user gives a poor rating to the business. If a reasonable number of users give a similarly poor rating to the same business, the business site will automatically ranked lower.

### **C. Independent Claims 1, 9, 17, and 25 in Light of the Cited References**

Applicant will now present arguments in support of the allowance of independent claims 1, 9, 17, and 25, and the claims dependent thereon, over the cited references. Claim 1, as a representative claim, recites the following elements that are not described in the cited references:

"1. **A self-correcting system** for use with a search engine to rank search results **based upon a ranking of businesses that are selected from an unrestricted pool of merchants**, comprising:

an on-line ranking system for receiving any of users' on-line surveys or feedback about businesses;

the on-line ranking system generating rating data from the any of the users' on-line surveys or feedback;

wherein the rating data correlates higher quality search matches to higher business satisfaction ratings;

wherein the on-line ranking system indexes the rating data;

an on-line ranking repository for storing the rating data indexed by the on-line ranking system;

a result sorter for sorting query results generated by the search engine, based on the rating data from the on-line ranking repository, and for generating ranked matches;

a profile manager for creating a user profile history from a user's address;

wherein the user profile history enables the user to update a rating that was previously provided by the user, and disables the user from revising ratings provided by other users; and

wherein updated cumulative business satisfaction ratings from the users' on-line surveys or feedback automatically cause the on-line ranking system to re-index the rating data, and further cause the result sorter to generate ranked matches based on the re-indexed rating data." (Emphasis added).

With reference to the pages from the BizRate web site, BizRate does not allow **ALL** the businesses on the WWW to be rated. In fact, page 8 clearly states: "We do not want to list every merchant on the Web, only those that can serve you best. As one of our users puts it: "If it ain't on BizRate, it ain't worth shopping at!"

As a result, BizRate does not describe a **self-correcting system** for use with a search engine to rank search results **based upon a ranking of businesses that are selected from an unrestricted pool of merchants**. One of the main



problems addressed by the present invention is to provide a better search based on an unrestricted pool of merchants, such as on the merchants on the Internet.

The present system is automatic in that it does not require an intermediary company, such as BizRate, to select the merchants first and then take into account the customers' feedback.

In addition, the present invention, contrary to BizRate, does not require the staff to spend "countless hours compiling detailed information on each merchant's capabilities and site features." Reference is made to page 8 of the BizRate cited reference.

Moreover, contrary to BizRate, the present invention opens up the entire pool of merchants all around the globe to being rated by users, whether these users are customers or not. BizRate's survey of customers' opinions is limited to customers who made purchases. Reference is made to the last paragraph on Page 19 of the BizRate cited reference.

In addition, BizRate does not provide a profile manager for creating a user profile history from a user's address, wherein the user profile history enables the user to update a rating that was previously provided by the user, and disables the user from revising ratings provided by other users, and wherein updated cumulative business satisfaction ratings from the users' on-line surveys or feedback automatically cause the on-line ranking system to

re-index the rating data, and further cause the result sorter to generate ranked matches based on the re-indexed rating data.

Applicant agrees with the Examiner that BizRate fails to teach the step of indexing the rating data, and an on-line ranking repository for storing the rating data indexed by the on-line ranking system. In order to compensate for the absence of these two important elements, the Examiner essentially argued that Peters teaches a system for obtaining surveys from a plurality of users (Peters, Col. 2, line 45-Col. 3, line 16), and that the survey answers with rating data are indexed and stored in a database (Peters, Col. 19, lines 46-57; Col. 21, line 65-Col. 22, line 13; Col. 30, lines 12-19).

Applicant submits that BizRate does not disclose "a result sorter for sorting query results generated by the search engine, based on the rating data from the on-line ranking repository, and for generating ranked matches", in that the rating data recited in this element must have been (1) indexed and (2) stored, which steps are admittedly lacking in BizRate.

Though Peters discloses the intake of surveys, it does not output sorted query results based on the "rating data". Applicant submits that "rating data" is clearly defined in the claims as rating data that correlates higher quality matches to higher business satisfaction rating. Thus, Peters does not disclose rating data as claimed herein, and therefore the combination of Peters and BizRate, if permissible, would still not yield the system and method as claimed herein.

In addition, Peters does not disclose the remaining elements that are missing from BizRate (as presented earlier).

Applicant incorporates by reference the presentation made earlier in support of the allowance of claim 1, and submits that the independent claims 9, 17, and 25 are similarly not obvious in view of combination of BizRate and Peters, for containing generally comparable elements and limitations. As a result, the independent claims 1, 9, 17, and 25 are allowable, and thus the claims dependent thereon are also allowable, and such allowance is respectfully requested.

#### **CONCLUSION**

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted,

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